UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,700	08/31/2001	Mikio Nagasawa	H-1007	8877

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ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
		09/942,700	NAGASAWA, MIKIO
Office Action Summary		Examiner	Art Unit
		Traci L Smith	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 August 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10</u> is/are rejected.

7)☒ Claim(s) <u>10</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   . Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This actions is in response to papers filed on August 31,2001.

2.   Claims 1-10 are pending

3.   Claim 10 is objected.

4.   Claims 1-10 are rejected.

5.   The IDS submitted on 08/31/2005 has been reviewed and considered by the

examiner.

Claim Objections

6.   Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because

a multiple dependent claim should refer to other claims in the alternative only. See

MPEP § 608.01(n). Accordingly, the claim 10 has not been further treated on the

merits.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.   Claims1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the

invention. The specification does not enable one skilled in the art to perform the following steps

a. Claim 1-Simulating estimated service performance: how does one simulate and what is used to simulate? What is an estimated performance and what information is used to get an estimate?

b. Claim 2-How does one define what is a quantity that is sufficient? What is used to determine the quantity and how does one know what it is compared to what will qualify as sufficient?

c. Claim 3-How does the average time get estimated? How is the maximum time determined? What information is used to estimate? What is the basis for the estimation?

d. Claim 4-claim states re-calculation, there is no initial formula calculation let alone a second formula that would allow for one skilled in the art to know how to re-calculate or what to use in the calculations.

e. Claim 5-what are the measures of reliability? How does one evaluate the measures?

f. Claim 10 recites algorithms with not such explanation in the specification as well as an arithmetic process with no mathematical computations in the specification.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claim1-10 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

11.   The claims are generally narrative and indefinite, failing to conform with current

U.S. practice. They appear to be a literal translation into English from a foreign

document and are replete with grammatical and idiomatic errors.

Claim Rejections - 35 USC § 101

12.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

13.   The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

14.   For a claimed invention to be statutory, the claimed invention must be within the

technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to

promote the "progress of science and the useful arts" (i.e., the physical sciences as

opposed to social sciences, for example) and therefore are found to be non-statutory

subject matter. For a process claim to pass muster, the recited process must somehow

apply, involve, use, or advance the technological arts.

15.   In the present case, claims 1-9 do not use or involve the technical arts. The

steps of the claimed method could simply be performed by a human process. Although

claims site a "computer platform" it is not clear as to how the platform is involved and

what if any of the steps is it performing in executing in the method.

Claim Rejections - 35 USC § 102

16.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

17.   Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by

US Patent 5 732 400 Mandler, et al; System and Methods for Risk-based Purchase of

goods. The examiner has applied the above reference to the claims as the examiner is

best able to understand the claims.

18.   As to claim 1 A method for providing information services comprising a means for

controlling brokering and booking resources for offering a service (the means will be

referred to as brokering means hereinafter):

a.   intervening between resources for information processing services be

offered by a plurality of providers of the resources *Mandler teaches process*

taking place with a broker acting between the buyer and seller.(C. 4 l. 5-7)

b.   for information processing services and administrators operating

information service systems including computer platforms (both the providers as

service resource providers hereinafter) and users of said resources, *Mandler*

teaches buyers, sellers and a clearinghouse administer service transactions.(C. 3

l. 33-34)

c.   said brokering means including resource performance holding credit data

data for the resource comprising the steps of; providers, *Mandler teaches*

teaches the financial clearing house using credit data to establish risk.(C. 3 l. 43-

46).

d.   said brokering means receiving performance request specifications of

resources for a user-desired service from the user; simulating estimated service

performance of resources based on said request specifications and said credit

data, thereby allocating one or more combinations of serviceable resources that

satisfy, in the aggregate, said request specifications; *Mandler teaches receiving a*

request from user. And upon preliminary approval transmit requests to sellers for

review.(C. 4 l.20-27).

e.   issuing a resource reservation ticket to the user, the ticket including data

that entitles the user to utilize said one or more combinations resources; *Mandler*

teaches issues a notice of the goods being shipped and an invoice so buyer can

purchase service.(C. 4 l. 39-43)

f.   and placing an order with the resource providers for said one or more

combinations of resources thereby booking the resources for the user. *Mandler*

teaches allowing the user the opportunity to purchase service(C. 4 l. 51-52).

As to claim 2, means executes simulation of the performance of

resources, based on the user's request specifications,

allocates the adequately-performing resources of one or more resource

providers, according to the result of the simulation, determines what quantity of

resources are necessary and sufficient for fulfilling said request specifications

Mandler supplies quotes in response to request(C. 7 l. 38-40).

and time during which function and resources are required to run, *Mandler*

teaches a time frame for the transaction(C. 15. l. 27-28)

issues resource reservation ticket, according to the allocation, *Mandler*

teaches giving the request a transaction ID associated with request for goods.(C.

7 l. 25-27).

wherein the brokering means will issue the respective resource

reservation tickets to plurality of service users (customers), *Mandler teaches*

providing quotes form multiple sellers for request.(C. 7 l. 40-42).

moreover, after successfully reserving resources, brokering means sends

the service performance request specifications, based on which the resources

have been reserved, to the providers of the allocated resources, *Mandler teaches*

sending Purchase order to seller for the services requested.(C. 7 l. 55-57)

and when resource providers determine their service resources required to execute the service in future, the brokering means compares available function and resources and required function and resources for a specific period and manages the thus obtained data decide whether the service providers can provide additional service performance resources. *Mandler teaches sellers selected by broker as meeting the performance specifications and ability to deliver goods. (C. 8 l. 41-44).*

19.   As to claim 3 *Mandler teaches transaction ID with a ll information or messages associated with the service.(C. 7 l. 25-28).*

20.   As to claim 4 *Mandler teaches negotiations between buyer and seller for meeting the requirements of the request.(C. 7 l. 55-58).*

21.   As to claim 5 *Mandler teaches choosing a seller based on performance criteria and quality of goods.(C. 8 l. 41-44).*

22.   As to claim 6, *Mandler teaches information used in determining both reliability of the buyer and the seller.(C 8 l. 34-40 & 48-50).*

23.   As to claim 7 *Mandler teaches determining which resources meet the specification of the users request(C. 7 l. 35-37 & 39-41). As well as using credit data in the determination(C. 7 l .30-31).*

24.   As to claim 8 *Mander teaches editing the information from one form of data to another using an EDI translator(C. 10 l .20-25). And electronically sending information(C. 7 l. 53-54). As well as a storage medium(Fig. 2 Ref 45).*

25.   As to claim 10 An apparatus for authenticating an authorized service user

comprising a means authorized service user authentication which authenticates that the

user authorized to use service by verifying the validity of the user's resource reservation

ticket issued to guarantee the right the service user and the performance resources to

execute the service, *Mandler teaches receiving authorization and verification of risk*

and approval message user qualifies for services requested.

26.   a first storage means to store said resource reservation ticket data, a second

storage means to store resource allocation information, *Mandler teaches multiple*

database used for storing different information.(Fig. 2 Ref. 45).   The examiner takes

notice that even though the reference teaches the use of more than one database the

fact that the applicant claims the data base for storing specific information this

information is considered non-functional descriptive matter. It does not matter what the

type of information is that is being stored. A database is going to store the data

regardless of what the information is therefore the steps of storing would be performed

the same way every time.

27.   a means for communication between said first storage means and second

storage means, *Mandler teahes a communication network(Fig. 1B Ref. 5 and Co. 6 l.*

22-23).

28.   and a means for verifying certificate data which executes predetermined

arithmetic processing based on algorithm for encryption/decryption and other security

purposes for the reservation data and resource allocation data and verifies the validity

of the resource reservation. *Mandler teaches evaluation of credit risk based on a variety of factors.(C. 6 l. 54-56).*

Conclusion

29.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Non-Patent Literature article from The Press-Enterprise; "Riverside firm launching Web portal: New site will provide services to retailers; Dec. 21, 1999. Foreign Patent JP 408320854A; Information Management System; Nonaka et al. For the above reasons, it is believed that the rejections should be sustained.

30.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is (703)605-1155. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

31.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

32.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tls

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